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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/580,813	05/26/2000	Thomas M. Keeley	460870.90018	9113
26710	7590	01/11/2005	EXAMINER	
QUARLES & BRADY LLP 411 E. WISCONSIN AVENUE SUITE 2040 MILWAUKEE, WI 53202-4497			NGUYEN, MAIKHANH	
		ART UNIT		PAPER NUMBER
				2176

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/580,813	KEELEY, THOMAS M.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Maikhhanh Nguyen	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 19 July 2004.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-16 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-16 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

***DETAILED ACTION***

1. This action is responsive to communications: Amendment filed 07/19/2004 to the original application filed 05/26/2000.
2. Claims 1-16 are currently pending in this application. Claims 1-16 have been amended. Claims 1 and 10 are independent claims.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16 remain rejected under 35 U.S.C. 103(a) as being unpatentable over **Hugh** (U.S. 6,256,032 – filed 01/2000) in view of **Marpe et al.** (U.S. 6,671,693 – filed 11/1999).

**As to independent claim 1:**

- a. Hugh teaches the invention substantially as claimed including a program for the organization of ideas using an electronic computer (*e.g., organizing and processing pieces of interrelated information ‘or thoughts’ using a digital computer; Abstract*), the electronic computer having a user input device and a

graphics display (*e.g., graphical user interface to facilitate user interaction; Abstract*), the program comprising instructions executed on the electronic computer to:

- (i) accept text identified ideas from a user via the user-input device (*e.g., the 'key words' of a thought ...inputted by the user; col.6, lines 15-24*);
- (ii) display representations of the text identified ideas on the graphic display as organized into levels defined by common dependency (*e.g., a graphical presentation of a portion of the matrix is displayed ... according to the thoughts ...hierarchical-based approaches; col.2, line 45-col.3, line 16*);
- (iii) accept from the user numeric priorities for the text identified ideas of at least one level (*e.g., a priority number set by the user indicates the relative importance of a particular thought; col.7, lines 11-17*); and
- (iv) arrange the text identified ideas of the at least one level on the graphic display (*e.g., the placement of the thoughts reflects second-level relations ... graphical presentation; col.7, line 64-col.8, line 11 & arrange portion of their information in a traditional hierarchical manner; col.28, lines 35-52*) according to the numeric priorities (*e.g., priority 230; col.7, lines 11-17 & thought lists ...priority levels; col.25, lines 26-37*).

b. Hugh, however, does not explicitly teach “accept at least one hierarchy instructions from the user via the user-input device, the hierarchy instructions relating the accepted text identified ideas in dependencies.”

- c. Marpe teaches accept at least one-idea hierarchy instructions from the user via the user-input device, the hierarchy instructions relating the accepted text identified ideas in dependencies (*e.g., Exploring or pre-writing is the process of brainstorming and taking unstructured notes ...relation among ideas, groups related ideas and constructs small hierarchical structures ...Organizing is the process of putting those notes or ideas in order, in the form of an outline or a hierarchy; col.12, lines 11-61& receiving data from multiple users in a plurality of categories, wherein the data is organized in a hierarchy of categories; col.54, lines 56-64*).
- d. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Hugh and Marpe because Map's teaching would have provided the capability for translating the abstraction of content and the relations of a hierarchical structure into a sequence of words, sentences, paragraphs, sections, chapters, and illustrations.

**As to dependent claim 2:**

Hugh teaches the displayed representation of the text identified ideas are text displayed in a text outline according to the dependencies of ideas associated with the text, the text outline including paragraphs arranged beneath other paragraphs on which they depend; and wherein the paragraphs of a level are ordered according to the numeric priorities of the text identified ideas to which they are related (*col.30, lines 13-38 & Fig.16*).

**As to dependent claim 3:**

Hugh teaches the displayed representations of the text identified ideas are node symbols arranged in a tree according to their dependencies, the tree structure including branches visually connecting node symbols to other node symbols on which they depend; and wherein the node symbols of a level are ordered according to the priorities of the ideas to which they are related (*col.5, lines 10-13/ col.7, lines 11-51/ col.9, lines 12-29 and col.25, lines 26-37*).

**As to dependent claim 4:**

Hugh teaches provide a list of representations of identified ideas of a level (*col.29, lines 8-24*) and wherein priorities are assigned by the user by changing the order of the representations of identified ideas within the list of representations of text identified ideas (*col.7, lines 10-17*).

**As to dependent claim 5:**

Hugh teaches allow changing of order of representations of identified ideas by selection of a given representation of an identified idea as displayed on the graphics display using the user input device and moving the representations of the identified idea within the list of representations of text identified ideas as displayed on the graphic display device using the user input device (*col.6, lines 45-65 & col.14, lines 10-23*).

**As to dependent claim 6:**

Hugh teaches when the representation of an identified idea is moved within the list of representations of text identified ideas to modify the numeric priority of at least one idea text identified idea so that the numeric priorities of all identified ideas in the list of

representations of text identified ideas remain monotonically decreasing (*col.23, line 43-col.24, line 24*).

**As to dependent claim 7:**

Hugh teaches provide a list of representations of text identified ideas of a common hierarchical level and to display a slide control for each text identified idea in the list of representations of text identified ideas that may be manipulated by the user input device to enter the numeric priorities (*col.24, line 1-24*).

**As to dependent claim 8:**

Hugh teaches decrease the numeric priority of all specific identified ideas in the list of representations of text identified ideas to beneath a given identified idea to a value less than value of the numeric priority of the given text identified idea (*col.7, lines 11- 17 & lines 40-51*).

**As to dependent claim 9:**

Hugh teaches increase the value of the numeric priority value of all specific text identified ideas in the list of representations of text identified ideas above a given text identification idea to a value at least equal to a value of the numeric priority of the specific text identified idea (*col.8, lines 55-col.9, line 11*).

**As to independent claim 10:**

- a. The rejection of independent claim 1 above is incorporated herein in full.  
Additionally, claim 10 further recites “after acceptance of a given text identified idea from the user in at least one predefined level, prompt the user as to additional

text identified ideas for inclusion in a next level having ideas dependent on the idea of the given text identified idea.”

- b. Hugh teaches after acceptance of a given text identified idea from the user in at least one predefined level, prompt the user as to additional text identified ideas for inclusion in a next level having ideas dependent on the idea of the given text identified idea (*col.8, line 55- col.9, line 49*).

**As to dependent claim 11:**

Hugh teaches the predefined categories are issue, position and argument and wherein the user is prompted with possible arguments when the given text identified idea is a position and the user is prompted with possible positions when the given text identified idea is an issue (*col.24, line 45-col.25, line 11*).

**As to dependent claim 12:**

Hugh teaches the user is prompted with a set of open-ended questions (*col.21, lines 36-54*).

**As to dependent claim 13:**

Hugh teaches the open-ended questions are augmented by text from the given text (*col.21, lines 36-54*).

**As to dependent claim 14:**

Hugh teaches allow the user to select from a set of predefined generic identified ideas and hierarchies and to provide an editor for editing the predefined generic identified ideas and hierarchies (*col.7, lines 28-51 & col.22, lines 13-38*).

**As to dependent claims 15-16:**

They include the same limitations as in claims 2-3, and are similarly rejected under the same rationale.

***Response to Arguments***

5. Applicant's arguments filed 08/18/2004 have been fully considered but they are not persuasive.

Applicant argues that *Hugh fails to teach the elements (ii) and (iii) of claims 1 and 10.* (Remarks, page 6)

In response, Applicant is arguing the reference individually. The combination of Hugh and Marpe shows how the references meet the claim limitations.

Applicant argues that *Hugh and Marpe, in combination, fail to show arrange text identified ideas in a hierarchical form according to user-entered numerical priorities as required by elements (iv) and (v) of claim 1.* (Remarks, page 6)

In response, Applicant is arguing the disclosure of the invention, not the claimed limitations. Elements (iv) and (v) do not require “a hierarchical form”.

Claimed subject matter, not the specification is the measure of the invention. Limitations in the specification cannot be read into the claims for the purpose of avoiding the prior art, In re Self, 213 USPQ 1,5 (CCPA 1982); In re Priest, 199 USPQ 11, 15 (CCPA 1978). The aforementioned claim elements are clearly subject to a broad interpretation, as detailed in the rejections maintained above.

Art Unit: 2176

As to dependent claims 2-9 and 11-16, the arguments are not persuasive for reason as discussed above with regards to independent claims 1 and 10.

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maikhahan Nguyen  
January 5, 2005



JOSEPH FEILD  
SUPERVISORY PATENT EXAMINER